

REMARKS

Claims 20-24 and 28-33 are now pending in this application, now the subject of a Request for Continued Examination (RCE). Claims 20, 23, and 30 are independent. Claims 20 and 22-24 have been amended; claims 28-33 have been added; and claims 1-19 and 25-27 have been canceled by this amendment. No new matter is involved with any new claim or claim amendment.

Indefiniteness Rejection Under §112¶2

Withdrawal of the rejection of claim 22 under 35 U.S.C. §112, second paragraph, as being indefinite, is requested. Claim 22 has been amended in a manner that is believed to overcome the stated basis for rejection. Allowance of claim 22 is requested.

Claim Rejection Under 35 USC § 101

Withdrawal of the rejection of claim 22 under 35 U.S.C. §101 is requested. Claim 22 has been amended in a manner that is believed to overcome the stated basis for rejection by setting forth steps associated with the use of the claimed security module. Allowance of claim 22 is requested.

Anticipation Rejection By Micali

Withdrawal of the rejection of claims 1-21 and 23-27 under 35 U.S.C. §102(b) as being anticipated by Micali (US 5,537,475) is requested. Claims 1-19 and 25-27 have been canceled, thus rendering their rejection moot.

The applied art fails to disclose each limitation of amended and new claims 20-24 and 28-33, as discussed *infra*.

At the outset, Applicant notes that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims.¹ There must be no difference

¹ *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. §102.² To properly anticipate a claim, the reference must teach every element of the claim.³ “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”.⁴ “The identical invention must be shown in as complete detail as is contained in the ...claim.”⁵ In determining anticipation, no claim limitation may be ignored.⁶

Discussion of Micali

Micali discloses a system and method for securing communication within a network by using algorithms for secure digital signatures. Micali does not disclose, teach, or suggest a module, system, or method for securely using a digital currency depot, as in Applicants’ claimed invention.

Specific Deficiencies of Micali

The applied art does not disclose a security module suitable for use with a digital currency depot for producing a forgery-proof document, wherein the module includes, among other features, “...means for ensuring that the forgery-proof document is produced only if actual sums of money are available to the digital currency depot”, as recited in independent claim 20, as amended.

Further, the applied art does not disclose a method for producing a forgery-proof document, which includes, among other features, “...interfacing with a digital currency depot; and ensuring that only sums of money actually available to the digital currency depot are used to produce the forgery-proof document”, as recited in independent claim 23, as amended.

² *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

³ See MPEP § 2131.

⁴ *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁵ *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁶ *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990).

Applicants claimed invention related to a security module that works together with a digital currency depot (e.g., vending type kiosk) to produce forgery-proof documents, *e.g.*, postage stamps, transportation tickets, or events tickets.

Accordingly, since the applied art does not disclose each claimed limitation of independent claims 20 and 23, reconsideration and allowance of claims 20-24 and 28-29 are respectfully requested.

New Claims

New dependent claims 28-29 have been drafted to avoid the applied art, and to further claim that which Applicants regard as their invention.

New system claims 30-33 have also been drafted to avoid the applied art, and to provide claims directed to a slightly different aspect of Applicants' original disclosure. The applied art does not teach or suggest all the limitations of these system claims.

For example, the applied art does not disclose, teach, or suggest "means for ensuring that a forgery-proof document is produced only if actual sums of money are available for use by the digital currency depot", as recited in newly-presented independent claim 30.

Support for the newly-presented claims may be found at least at pages 9-14 of the Specification.

Consideration and allowance of claims 28-33 are respectfully requested.

Conclusion

In view of the above amendment and remarks, Applicants believe that each of pending claims 20-24 and 28-33 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number indicated below.

For any fees that are due, including fees for extensions of time and a RCE, the Director is hereby authorized to charge any fees or credit any overpayment during the pendency of this application to CBLH Deposit Account No. 22-0185, under Order No. 10096-00001-US from which the undersigned is authorized to draw.

Dated: December 8, 2006

Respectfully submitted,

Electronic signature: /Larry J. Hume/
Larry J. Hume

Registration No.: 44,163
CONNOLLY BOVE LODGE & HUTZ LLP
1990 M Street, N.W., Suite 800
Washington, DC 20036
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicant